

### **III. REMARKS**

Claims 1-8 are pending in this application. By this amendment, claim 1 has been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-8 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1-8 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1-8 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alter, Steven; *Information Systems: A Management Perspective*, 2<sup>nd</sup> Edition, The Benjamin/Cummings Publishing Company, 1996 (hereafter “Alter”).

#### **A. REJECTION OF CLAIMS 1-8 UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The Office has asserted that claim 1-8 are indefinite for failing to comply with the enablement requirement. Specifically, the Office states that the limitations of the claims are representative of subjective steps that may be performed in the mind of the user. Applicants have amended claim 1 to recite “...defining a project business need” and “...defining a project technical need.” Applicants assert that this amendment further objectifies the invention by providing the claimed invention with a more concrete starting point of a defined project business

need and project technical need from which the later steps may be accomplished. Accordingly, Applicants request that the rejection be withdrawn.

## **B. REJECTION OF CLAIMS 1-8 UNDER 35 U.S.C. §101**

The Office has rejected claims 1-8 for allegedly being directed to non-statutory subject matter. Specifically, the Office states that the claimed invention does not produce a useful result. Applicants have amended claim 1 to recite, “[a] project management method for optimizing Information Technology (IT) sites including skilled people groups and computer equipment to achieve a cost savings.” Applicants submit that the cost savings of the claimed invention represents both a concrete and tangible result as well as solving a problem in the art. Claims 2-8 depend from claim 1. As such, Applicants assert that this amendment further directs the invention to statutory subject matter. Accordingly, Applicants request that the rejection be withdrawn.

## **C. REJECTION OF CLAIMS 1-8 UNDER 35 U.S.C. §103(a)**

With regard to the 35 U.S.C. §103(a) rejection over Alter, Applicants assert that Alter does not teach each and every feature of the claimed invention. For example, with respect to independent claim 1, Applicants submit that Alter fails to teach determining, according to the project business need, a number of IT sites spread over a geographic area and determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area. The passages of Alter cited by the Office describe data centers that can be located at the corporate headquarters, regional processing centers, site

processing center, departments processors, workgroup processors, or at individual client machines, but does not teach or suggest that its data centers are determined according to a pre-defined business process need. The passage of Alter also describe distinct roles being assigned to specific personnel who have the requisite skill set to perform the assigned tasks but does not teach that the personnel are determined according to a pre-defined project technical need. In contrast, the claimed invention includes "...determining, according to the project business need, a number of IT sites spread over a geographic area; determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area;." Claim 1. As such, unlike the data centers and specific personnel of Alter, the number of IT sites and skilled people groups are determined based on specific pre-defined criteria. Thus, Alter does not teach the determining steps of the claimed invention. Accordingly, Applicants respectfully requests that the Office withdraw its rejection.

With further respect to independent claim 1, Applicants respectfully submit that Alter also fails to teach or suggest consolidating the IT sites of the geographic area by considering project cost parameters and geographic site location peculiarities. Alter teaches that a cost-benefit analysis may be performed, but does not teach considering geographic site location peculiarities in addition. These geographic peculiarities may include, for example, local laws, local customs, etc. Thus, the cost benefit analysis of Alter does not teach the consolidating of the IT sites of the claimed invention. Accordingly, Applicants request that the rejection be withdrawn.

With further regard to the 35 U.S.C. §103(a) rejection over Alter, Applicants respectfully assert that there is no support in Alter for extrapolating the teachings of Alter to make the

claimed invention obvious in light of its teachings. Specifically, Alter seeks to provide guidelines to a company for use in investments in systems. Page 570, Selecting Systems to Invest In, first paragraph. However, Alter specifically states that "...there is no ideal formula for deciding which systems and capabilities to invest in." Id at second paragraph. In contrast, the claimed invention provides a method having steps for optimizing IT sites to achieve a cost savings. To this extent, there would be no expectation of success in the Office's proposed extrapolation of Alter to achieve the specific method of the claimed invention. As such, the Office has failed to prove a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection be withdrawn.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of this rejection.

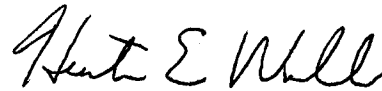
#### **IV. CONCLUSION**

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's

combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



---

Hunter E. Webb

Reg. No.: 54, 593

Date: July 3, 2006

Hoffman, Warnick & D'Alessandro LLC  
75 State Street, 14<sup>th</sup> Floor  
Albany, New York 12207  
(518) 449-0044  
(518) 449-0047 (fax)

RAD/hew